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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/857,229	08/20/2001	Blue John Ramsey	78104.025	9574

7590 10/21/2004

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EXAMINER

WONG, EDNA

ART UNIT	PAPER NUMBER
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1753

DATE MAILED: 10/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/857,229

Applicant(s)

RAMSEY ET AL.

Examiner

Edna Wong

Art Unit

1753

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34 and 36-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34 and 36-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 15, 2004 has been entered.

This is in response to the Amendment dated October 15, 2004. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Response to Arguments

Claim Rejections - 35 USC § 112

I. Claims **36-37 and 43-47** have been rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The rejection of claims 36-37 and 43-47 under 35 U.S.C. 112, first paragraph, has been withdrawn in view of Applicants' remarks.

II. Claims **39-41 and 44-47** have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The rejection of claims 39-41 and 44-47 under 35 U.S.C. 112, second paragraph, has been withdrawn in view of Applicants' remarks.

Claim Rejections - 35 USC § 103

I. Claims **1 and 20-29** have been rejected under 35 U.S.C. 103(a) as being unpatentable over **Seeger, Jr. et al.** (US Patent No. 4,759,970) in combination with **WO 97/48257**.

The rejection of claims 1 and 20-29 under 35 U.S.C. 103(a) as being unpatentable over Seeger, Jr. et al. in combination with WO 97/48257 has been withdrawn in view of Applicants' amendment. Claims 1 and 20-29 have been cancelled.

II. Claim **2** has been rejected under 35 U.S.C. 103(a) as being unpatentable over **Seeger, Jr. et al.** (US Patent No. 4,759,970) in combination with **WO 97/48257** as applied to claims 1 and 20-29 above, and further in view of **Haney et al.** (US Patent No. 4,411,980).

The rejection of claim 2 under 35 U.S.C. 103(a) as being unpatentable over Seeger, Jr. et al. in combination with WO 97/48257 as applied to claims 1 and 20-29 above, and further in view of Haney et al. has been withdrawn in view of Applicants'

amendment. Claim 2 has been cancelled.

III. Claims **19 and 30** have been rejected under 35 U.S.C. 103(a) as being unpatentable over **Seeger, Jr. et al.** (US Patent No. 4,759,970) in combination with **WO 97/48257** and **Haney et al.** (US Patent No. 4,411,980) as applied to claim 2 above, and further in view of **Brandt et al.** (US Patent No. 5,922,397).

The rejection of claims 19 and 30 under 35 U.S.C. 103(a) as being unpatentable over Seeger, Jr. et al. in combination with WO 97/48257 and Haney et al. as applied to claim 2 above, and further in view of Brandt et al. has been withdrawn in view of Applicants' amendment. Claims 19 and 30 have been cancelled.

Response to Amendment

Claim Rejections - 35 USC § 112

Claims **41 and 47** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 41

line 2, "the ... second electrically conducting layer" lacks antecedent basis.

Claim 47

line 2, "the ... second electrically conducting layer" lacks antecedent basis.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims **34 and 36-47** are rejected under 35 U.S.C. 102(e) as being anticipated by **Suzuki et al.** (US Patent No. 6,051,645).

Suzuki teaches a lithographic ink comprising:

(a) a metal (= magnetic fine particles) [col. 8, lines 19-21] or carbon (= carbon black) [col. 7, lines 61-66] particulate material suspended in a mixture of:

(i) a resin (col. 5, lines 28-36; and col. 19, claim 8);

(ii) an antioxidant (col. 9, lines 43-47); and

(iii) an organic solvent (col. 9, lines 11-28).

wherein the resin comprises a polyamide (= polyamide resin) [col. 5, lines 28-36; and col. 19, claim 8].

As to the claim limitation of “for use in a lithographic printing process onto a polymer substrate”, the intended use of the ink does not compositionally distinguish the ink from the prior art.

As to the claim limitations of claims 36-38 and 42-44, what the ink is printed on is the intended use of the ink does not compositionally distinguish the ink from the prior art.

As to the claim limitations of claims 39, 41, 45 and 47, attaching an electrical component does not compositionally distinguish the ink from the prior art.

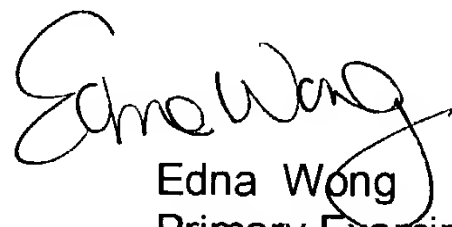
As to the claim limitations of claims 40 and 46, electroplating a second electrically conducting layer does not compositionally distinguish the ink from the prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edna Wong whose telephone number is (571) 272-1349. The examiner can normally be reached on Mon-Fri 7:30 am to 3:30 pm, Flex Schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Edna Wong
Primary Examiner
Art Unit 1753

EW
October 19, 2004